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PATENT APPLICATION NO.
08/425,766

In The United States Patent and Trademark Office
On Appeal From The Examiner To The Board
of Patent Appeals and Interferences

In re Application of:	Ralph F. Greene et al.
Serial No.:	08/425,766
Filing Date:	April 19, 1995
Examiner:	Marc E. Norman
Group Art Unit:	3744
Appeal No.:	2000-0918
Title:	*Method and Apparatus for Disposing of Waste Material*

Mail Stop: Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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Willie Jiles

Willie Jiles

Date: March 14, 2005

Dear Sir:

Reply Brief

Appellants respectfully submit this Reply Brief under 37 C.F.R. § 41.41(a)(1) in response to the Examiner's Supplemental Answer mailed January 14, 2005.

By way of background, on June 28, 1999, Appellants filed a Notice of Appeal from the Examiner's Final Office Action mailed March 30, 1999. Appellants subsequently filed an Appeal Brief on August 30, 1999, explaining why the final rejection was improper. The Examiner mailed an Answer to Appellant's Appeal Brief on December 31, 1999, and Appellants filed a Reply Brief in response to the Examiner's Answer on February 22, 2000. On February 28, 2002, the Board issued an Order requiring Appellants to file a Supplemental

Appeal Brief addressing the Federal Circuit's decision in *Pannu v. Storz Instruments, Inc.*, handed down July 25, 2001, and its impact on the final rejection on appeal. 258 F.3d 1366, 59 U.S.P.Q.2d 1597 (Fed. Cir. 2001). Appellants filed the required Supplemental Appeal Brief on April 9, 2002. On July 31, 2003, the Board remanded the present application to the Examiner to determine whether the final rejection on appeal was appropriate under the Board's precedential opinion in *Ex Parte Eggert*, decided May 29, 2003. 67 U.S.P.Q.2d 1716 (Bd. Pat. App. and Interf. 2003). In response to the remand, the Examiner mailed a Supplemental Answer on January 14, 2005, maintaining the final rejection here on appeal.

Argument

In the Examiner's Supplemental Answer, the Examiner states:

> In *Ex Parte Eggert*, the Board of Patent Appeals and Interferences rendered a decision stating that a reissue claim that broadens a limitation relied upon to overcome a rejection would avoid the recapture rule since the relied-upon limitation is still present in the claim, albeit in a broadened form.
>
> The Examiner submits that the decision regarding *Ex Parte Eggert* is not directly relevant to the present case. The only rejection in the present reissue application is based on recapture of subject matter surrendered by arguments made during prosecution of the original application.

(Examiner's Supplemental Answer, Pages 3-4). The Examiner then proceeds to reiterate arguments that the Examiner presented in the Examiner's Final Office Action and in the Examiner's Answer, without presenting any new arguments supporting the final rejection on appeal. Below, Appellants specifically discuss the relevance of *Ex Parte Eggert* to this Appeal.

Ex Parte Eggert is Relevant to This Appeal

In *Ex Parte Eggert*, the Board held that the recapture rule is limited to subject matter actually presented to the Examiner during prosecution of the original patent application. 67 U.S.P.Q.2d at 1717. Thus, when an applicant narrows a claim by amendment to overcome a rejection based on prior art, the applicant surrenders only the subject matter present in the broader version of the claim that the applicant removed by amendment. *See id.* The narrowing amendment does not constitute surrender of any subject matter lying between the boundaries of the broader version of the claim and the narrower version of the claim, since such subject matter was not present in the broader version of the claim. *See id.*

Ex Parte Eggert specifically addresses surrender by amendment, whereas this Appeal concerns surrender by argument, but Appellants submit that portions of the Board's opinion in *Ex Parte Eggert* are still relevant to this Appeal.

In *Ex Parte Eggert*, the Board noted that merely arguing a limitation does not give rise to surrender under the recapture rule:

> The examiner contends that the recapture rule prohibits a patentee from obtaining in reissue any claim which does not include ***each and every limitation*** added to a claim or ***argued by an applicant*** during the prosecution of the original patent application in order to overcome a rejection and obtain a patent. ***This approach . . . has been expressly rejected*** by the Court of Customs and Patent Appeals . . . and the Court of Appeals for the Federal Circuit.

Id. at 1723 (citations omitted) (emphasis added). Appellants have pointed out that, despite the Examiner's assertions to the contrary, the arguments made during prosecution of the original application demonstrate only that the limitation Appellants now seek to remove was one of several limitations that each provided a patentable distinction over the references at issue. (Appellants' Appeal Brief, Page 6-9, and Appellants' Reply Brief, Pages 3-4). Applying the recapture rule based on such arguments would clearly run afoul of the above assessment of the recapture rule in *Ex Parte Eggert*.

Moreover, the final rejection here on appeal relies on the Federal Circuit's decision in *Hester Industries Inc. v Stein Inc.*, which specifically addresses surrender by argument. 142 F.3d 1472, U.S.P.Q.2d 1641 (Fed. Cir. 1998). In *Ex Parte Eggert*, the Board discusses *Hester Industries*:

> The *Hester* court, however, concluded that "in a proper case, a surrender can occur through arguments alone." With this in mind, the *Hester* court then determined that the applicant's repeated arguments during prosecution of the patent application that the "solely with steam" and "two sources of steam" limitations distinguished the original claims from the prior art and were "critical" and "very material" with regard to patentability constituted an admission that these limitations were necessary to overcome the prior art and, hence, resulted in a surrender of "claim scope that does not include these limitations" (i.e., claim 1 without the "solely with steam" and "two sources of steam" limitations).

Id. at 1726 (citations omitted). Thus, the Board noted that in *Hester* the applicant had argued the limitations ultimately held surrendered ***repeatedly*** and had further characterized

the limitations ultimately held surrendered as ***critical*** and ***very material*** to distinguishing the claims at issue over the prior art. *Id.* Appellants have pointed out that Appellants did not, during prosecution of the original application, ***repeatedly*** argue the limitation Appellants now seek to remove or characterize the limitation that Appellants now seek to remove as ***critical*** or ***very material***, as did the applicant in *Hester*. (Appellants' Appeal Brief, Page 6-9, and Appellants' Reply Brief, Pages 3-4). Because the arguments made during prosecution of the original application are limited in such respects, the arguments made during prosecution of the original application clearly fail to give rise to surrender under *Hester*.

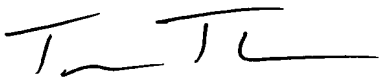
Conclusion

Appellants have demonstrated that the present invention, as claimed, complies with all statutory requirements for a U.S. Patent. Therefore, Appellants respectfully request the Board to reverse the final rejection of the Examiner and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

Appellants believe no fees are due. Nonetheless, the Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellants



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Date: March 14, 2005

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